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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/605,859      | 10/31/2003  | Jacqueline Ann Lewchenko | 36135-400100        | 2858             |

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| EXAMINER |
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MERCIER, MELISSA S

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| ART UNIT | PAPER NUMBER |
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1615

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 03/19/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/605,859  | <b>Applicant(s)</b><br>LEWCHENKO, JACQUELINE ANN |  |
|                              | <b>Examiner</b><br>Melissa S. Mercier | <b>Art Unit</b><br>1615                          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-8 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application  
 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt of Applicants Remarks and Amended Claims filed on February 15, 2007 is acknowledged. Applicant has cancelled claims 9-11. Claims 1-8 are pending in this application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Perricone et al. (US Patent 6,162,419).

Perricone teaches a composition suitable for topical use comprising "fatty acid esters of ascorbic acid, particularly saturated fatty acid esters such as ascorbyl palmitate, their salts, ascorbic acid and its salts. Useful solvents include polyethylene glycol, ethoxydiglycol, propylene glycol, butylene glycol, propylene carbonate, glycerin, a capric glyceride, a caprylic glyceride, an alkyl lactate, an alkyl adipate, an isosorbide, and mixtures thereof" (abstract). Additionally, "the solvent or solvent mixtures are selected to be conducive to topical application, and ones that form a film or layer on the skin to which the composition is applied so as to localize the application and provide some resistance to washing off by immersion in water or by perspiration and/or one which aids in percutaneous delivery and penetration of the ascorbyl fatty acid ester into

Art Unit: 1615

lipid layers are particularly preferred. In many embodiments, compositions of the invention contain a penetration enhancer such as oleic acid and/or urea; typical concentrations range from about 0.5% to about 10% by weight. Compositions may also contain acrylate/meteth copolymers( column 5, lines 22-34).

Perricone's example of a "7% cream comprising:

Urea (film former) and 0.64% weight/weight Gotu Kola Extract" (column 9, lines 15-39).

Regarding Claims 2-3, Perricone's example of the 7% cream comprises 0.64% weight/weight Gotu Kola Extract" (column 9, line 38).

Regarding Claim 7, Perricone's example of the 7% cream comprises carbomer, which is a known polymer of acrylic acid, used as an emulsifier or thickening agent (column 9, line 17) and polysorbate-20, which is a known emulsifier or viscosity controlling agent (column 9, line 28).

Regarding Claim 8, ascorbic acid is also known as Vitamin C, additionally, Perricones example of the 7% cream further comprises tocopherol acetate or vitamin E. (column 9, line 29).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues The Perricone patent fails to teach a treatment or application used for fingernails. Despite the long recitation of the various uses of the compositions, the Perricone patent fails to suggest that fingernails may be strengthened with the compositions. Applicant is reminded that intended use of a composition does not hold

Art Unit: 1615

patentable weight in determining patentability of a composition. The Perricone reference discloses the same composition as that claimed in the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, and 4-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Perricone et al. (US Patent 6,162,419) in view of Cook (US Patent 5,985,951).

Perricone's teachings as they apply to Claim 1 are discussed above and applied in the same manner.

Perricone does not teach the use of plasticizers, UV radiation absorbers, and pigments.

Cook teaches, "an improved cosmetic employing a coloring agent and a plasticizer in a volatile solvent includes a film-forming agent, as well as a cosmetic

Art Unit: 1615

pigment”(abstract). The composition can further comprise “ultraviolet absorbers; UV light stabilizers; tinting pigments; thickening agents; or coalescing agents” (column 9, lines19-29).

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components typically found in topical cosmetic compositions. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive .In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***


No Claims are allowable. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1615

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
Gollamudi S. Kishore, PhD  
Primary Examiner  
Group 1500

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'MSMercier', with a stylized, cursive script.

MSMercier